

REMARKS

Claims 1, 3-20, 22-37, and 39-54 were pending in this application. By this amendment, claims 1, 18, 23, 24, 29, 34-37, 41, and 42 are amended, new claims 55-57 are added, and claims 19, 20, and 39 are cancelled. No new matter has been added. In view of the above amendments and the following remarks, Applicants request reconsideration and withdrawal of the outstanding rejections.

Rejections under 35 U.S.C. § 101

Claims 1, 3-18, 20, 22-37, and 39-54 stand rejected under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. However, Applicants believe these claims as presented herein fully satisfy the requirements of 35 U.S.C. § 101.

Specifically, claim 1, as amended herein, recites:

1. A method of dynamically assigning usage rights to digital content for use in a system having at least one repository, said method comprising:
 - specifying, using a processor, a usage right, the usage right comprising computer readable data stored on a recording medium, the data of the usage right specifying an authorized use of digital content and being enforceable by a repository;
 - determining, using a processor, a status of a dynamic condition; and
 - dynamically assigning, using a processor, the usage right to the digital content based on the status of the dynamic condition,wherein access to the digital content is controlled by the repository through enforcement of the usage right assigned to the digital work.

Claim 18, as amended herein, recites:

18. A system for dynamically assigning usage rights to digital content and including at least one repository, said system comprising:

a processor for specifying a usage right, the usage right specifying an authorized use of digital content and being enforceable by a repository;

a processor for determining a status of a dynamic condition; and

a processor for dynamically assigning the usage right to the digital content based on the status of the dynamic condition,

wherein access to the digital content is controlled by the repository through enforcement of the usage right assigned to the digital work.

Claim 37, as amended herein, recites:

37. A device for enforcing usage rights assigned to digital content, said device comprising:

a repository for receiving the digital content;

a processor for requesting use of the digital content; and

a repository for enforcing use of the digital content in accordance with a usage right specifying an authorized use of the digital content, wherein the usage right is dynamically assigned to the digital content based on a determined status of a dynamic condition.

Thus, amended claims 1, 18 and 37 are each clearly tied to a machine because each claim recites the use of at least one processor and/or at least one repository, in addition to the reasons set forth in the appeal brief. Those claims dependent on claims 1, 18, and 47 also satisfy the requirements of 35 U.S.C. § 101 by virtue of their dependency on these claims. Thus, Applicants respectfully submit that these claims clearly satisfy the requirements of 35 U.S.C. § 101, and respectfully request withdrawal of the rejection of these claims under 35 U.S.C. § 101.

Rejections under 35 U.S.C. § 112

Claims 1, 3-20, 22-37, and 39-54 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Regarding claims 1 and 18, and those claims dependent thereon, the Examiner asserts that the phrase “being enforceable by a repository” is unclear, and sets forth a broad and unsupported interpretation of the meaning of this phrase on page 5 of the office action. Contrary to the Examiner’s position, the phrase “being enforceable by a repository” does not mean that the usage right is attached to work via a watermark or that the usage right is

specified using a usage rights language. After discussing this issue with the Examiner, Applicants claim 1 herein to recite “wherein access to the digital content is controlled by a repository through enforcement of the usage right assigned to the digital work” to clarify that the enforcement of the usage right by the repository enables the repository to control access to the digital content. Thus, Applicants believe it is clear that the usage right is not just a legal right, but is rather a right that can be enforced after it is assigned to a digital work, and that the enforcement elements of the present invention are preferably embodied in repositories. Therefore, Applicants respectfully request reconsideration and withdrawal of these rejections under 35 U.S.C. § 112.

Regarding claims 18-20, 22-37, and 39-54, the Examiner asserts that these claims invoke 35 U.S.C. § 112, 6th paragraph, specifically with respect to the “means for” limitations. However, the “means for” limitations in these claims have been replaced herein with more descriptive phrases that more clearly satisfy the requirements of 35 U.S.C. § 112. Accordingly, Applicants request reconsideration and withdrawal of these rejections under 35 U.S.C. § 112.

Rejections under 35 U.S.C. § 102 and § 103

Claims 1, 6, 8-20, 25, 27-37, 39, 43, and 45-54 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Stefik et al., U.S. Patent No. 5,638,443. In addition, claims 1, 3, 6-20, 22, 25-37, 39, 40, and 43-54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stefik et al. in view of Grosh, U.S. Patent No. 6,195,646. Furthermore, claims 4, 5, 23, 24, 41, and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stefik, Grosh, and either Applicants’ Admitted Prior Art or Cox et al., U.S. Patent No. 5,930,369. Applicants respectfully disagree and submit that none of Stefik, Grosh, Cox, or AAPA, taken alone or in combination, disclose or suggest the claimed invention.

The present invention is generally directed to a method, system and computer program product for dynamically assigning usage rights to digital works. See Abstract and at least paragraphs [0002, 0010, and 0029-0030] of the present specification. For example, a user employs a computer to download a digital work from a distributor’s server. The server specifies a usage right authorizing use of the digital work that is enforceable by a repository. The server

tracks dynamic conditions that may affect the usage right of the digital work. The server assigns the usage right to the digital content in accordance with the dynamic conditions. See paragraphs [0019-0021, 0029, and 0030] of the present specification.

Regarding Stefik, Applicants maintain their position that Stefik fails to disclose dynamically assigning a usage right to the digital content based on the status of the dynamic condition as is recited in the claims. Specifically, there is no disclosure of *assigning* usage rights based on dynamic conditions. Instead, the Stefik patent teaches that conditions can be part of a usage right and that the authorized use defined by the right can include conditions. The conditions of the Stefik patent govern how the digital content can be used after the usage right is assigned to the content. However, *such conditions do not relate to how the rights are assigned to content* in the Stefik patent.

The step of “assigning” usage rights is the step of tying the usage rights to an instance of content so that those rights will govern use of the content. Prior to assignment, rights do not govern use of content. The usage rights disclosed in the Stefik patent, including a manner of use and conditions, are assigned to content. See Figure 1 step 102 and column 6, lines 16-49 of the Stefik patent. That is, the content is created (step 101 of Figure 1) and usage rights are attached, i.e. assigned, to the content, and the combination of the content and the usage rights is deposited in a repository (step 102 of Figure 1). Conditions of the assigned rights can then be considered after assignment of the rights to govern use of the content.

In contrast, the claims in the present application recite that the usage rights are *assigned* based on the status of dynamic conditions. The terms “assigned” and “assignment,” as used in the present specification, clearly refer to the association between the rights and the content. Prior to assignment, the rights are not associated with the content. See paragraphs [0010 and 0029] of the present application, for example.

In making his rejection, the Examiner asserts that the Stefik patent dynamically assigns and determines using a computer system and/or instructions stored on a computer readable medium. For example, the Examiner asserts that Stefik discloses that Time 1455 can be a dynamic condition, and that rights are dynamically assigned based on this dynamic condition.

However, while Stefik discloses that time may be a condition as discussed above, the conditions of the assigned right are only considered after the right has been assigned to the content.

Specifically, Applicants respectfully submit that the portions of Stefik referenced by the Examiner are not disclosing time as a dynamic condition, but rather describing time synchronization between repositories. The condition in this example here would be better described as “clock drift” or “clock synchronization” rather than “time”. According to Stefik, if the “clock drift” is too large, the whole transaction is aborted. This is not a dynamic condition upon which assignment of rights is based because there is no transaction if the clocks of the two repositories are too far out of sync.

While discussing the time condition of Stefik, the Examiner states that “the copy right is governed by a variety of measured times, see C21 L32-47, and in this way rights assigned when a new copy of a digital work is created are based on time.” However, the portions of Stefik relied upon by the Examiner is no way disclose that rights are assigned “when a new copy of a digital work is created are based on time,” and the Examiner fails to point to any further section of Stefik that discloses that rights may be assigned in this fashion.

In addition to the time condition, the Examiner further asserts that Stefik discloses a dynamic copy count condition, and that are dynamically assigned based on this dynamic condition. Specifically, the Examiner asserts that “the ability of a repository to create another copy and assign it rights is governed by the copy-count for the copy right. If this is zero, a copy cannot be created. If this is greater than zero, a copy can be created.” In other words, the copy-count controls the making of copies. If there is no copy-count left, no copies can be made. Contrary to the assertions of the Examiner, this is not a dynamic assignment of rights, because, for example, there is no copy made if the copy-count is zero.

In an effort to overcome the deficiencies of Stefik, the Examiner asserts that Grosh discloses assigning usage rights based on a dynamic condition, such as pricing and purchase conditions. However, contrary to the assertions of the Examiner, the pricing structure in Grosh is already assigned to the work before distribution, and it is merely “calculated” at the time of distribution. The distributed work in Grosh has no usage rights attached to it, so there is no need

for dynamically assigning rights at distribution time. Thus, Grosh fails to overcome the above-noted deficiencies of Stefik.

AAPA and Cox et al. also fail to overcome the above-noted deficiencies of Stefik and Grosh. For example, Cox et al. discloses a secure spread spectrum watermarking technique that embeds a unique identifier into the perceptually significant components of a decomposition of an image, an audio signal, or a video sequence, but fails to disclose or suggest dynamically assigning a usage right to the digital content based on the status of a dynamic condition. Cox et al. instead merely discloses a technique for inserting digital watermarks in a data file. There is no usage right in Cox et al.

In contrast to the disclosures of Stefik, Grosh, Cox, and the AAPA, the claimed invention provides that the usage rights are dynamically assigned to content based on dynamic conditions occurring before, or at the time of association of the rights with content.

Thus, for at least the above-stated reasons, Stefik fails to disclose each and every feature recited in claims 1, 6, 8-20, 25, 27-37, 39, 43, and 45-54, and thus, does not anticipate these claims. In addition, none of Stefik, Grosh, Cox et al., or the AAPA, taken alone or in combination, disclose, suggest, or render obvious the invention recited in claims 1, 3-20, 22, 23, 25-37, 39, and 40-54. Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103 be reconsidered and withdrawn.

Claim Interpretations

On pages 16-17 of the Office Action, the Examiner sets forth dictionary definitions of various claim terms including “assign,” “dynamic,” “determine,” and “specify.” These terms are defined in the specification, and to rely on extrinsic sources, such as a dictionary, to define these terms in an arbitrary fashion is improper. For example, the Examiner asserts that “assign” means “to transfer (one’s right, interest, or title to property) to someone else.” In contrast, this term is clearly defined in the specification as “The usage rights can be assigned in any known manner, such as through techniques disclosed in the patents cited above and incorporated by reference.”

Applicants do not agree with the Examiner's use of a dictionary to define, in an arbitrary fashion, these terms which are known in the relevant arts, and respectfully request that the Examiner rely instead on the definitions and examples set forth in the specification and other documents incorporated by reference.

Additional Findings of Fact

Similar to the above, the Examiner has defined many claim terms on pages 17-21 of the Office Action using not the specification or the patents cited therein, but instead by using the disclosure of Stefik. While some of the definitions are accurate, Applicants do not agree with the Examiner's strategy in this regard, and respectfully request that the Examiner rely instead on the specification to define claim terms. If the Examiner would like further clarification in this regard, Applicants request that the Examiner contact the undersigned.

Conclusions

For the reasons above, all of the pending claims are in condition for allowance and such allowance is solicited. However, if the Examiner deems that any issue remains after considering this response, the Examiner is invited to contact the undersigned attorney to expedite the prosecution and engage in a joint effort to work out a mutually satisfactory solution.

Respectfully submitted,

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